UNITED STATES PATENT AND TRADEMARK OFFICE

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IBM CORPORATION, INTELLECTUAL PROPERTY LAW
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EXAMINER
BETIT, JACOB F

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte DOUGLAS R. FISH and HOA T. TRAN

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Appeal 2009-003170
Application 10/731,079
Technology Center 2100

_____

Decided: February 24, 2010

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Before JAMES D. THOMAS, LEE E. BARRETT, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
rejection of claims 1, 2, and 4-8, 12, 13, and 15-20. Appellants do not
appeal the Examiner's rejection of claims 9-11. Claims 3 and 14 have been
cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

INVENTION

Appellants' invention relates generally to the field of data entry and retrieval. More particularly, the invention on appeal is directed to a method and system for retrieving annotation data associated with a variety of heterogeneous data objects. (Spec., para. [0002]).

ILLUSTRATIVE CLAIM

1.   A method for providing annotation information for a set of data, comprising:

querying an annotation store to retrieve one or more annotation records, each annotation record associated with a portion of the set of data and having one or more annotation fields, wherein the set of data is a relational table containing query results;

generating a linking value identifying the portion of the set of data associated with the annotation records;

consolidating data contained in the annotation fields;

returning an annotation data structure comprising a field containing the linking value and a field containing the consolidated data; and

joining the annotation data structure with the set of data using the generated linking value.

PRIOR ART

Bays   US 6,519,603 B1   Feb. 11, 2003

THE REJECTIONS

1.   The Examiner rejected claims 1, 2, and 4, 7-13, and 15-20 under
      35 U.S.C. §§ 102(e) and 102(a) as anticipated by Bays.[1]

2.   The Examiner rejected claims 5 and 6 under 35 U.S.C. § 103(a) as
      unpatentable over the combination of Bays and Official Notice.

CONTENTIONS BY APPELLANTS

Appellants contend, *inter alia*, that Bays does not teach or suggest
"returning an annotation data structure comprising a field containing the
linking value and a field containing the consolidated data," and "joining the
annotation data structure with the set of data using the generated linking
value." (Claim 1, *see also* App. Br. 11-12).

THE EXAMINER'S RESPONSE

The Examiner disagrees. The Examiner construes the claim term
"field" broadly and proffers several dictionary definitions in support of the
applied broad interpretation. (Ans. 9). The Examiner finds that Bays

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[1] The Notice of Appeal does not specifically list which claims are appealed.
Appellants indicate in their Brief that they are only appealing the Examiner's
final rejection of claim 1, 2, 4-8, 12-13, and 15-20. (App. Br. 1). However,
claims 9-11 are also pending and are subject to an anticipation rejection over
Bays which has not been withdrawn (*see* Ans. 3; Final Rejection 2).
Therefore, it is clear that Appellants do not intend to appeal the final
rejection of claims 9-11. Consistent with the holding of BPAI precedential
opinion *Ex Parte Ghuman*, 88 USPQ2d 1478, 1480 (BPAI 2008), the
Examiner should cancel non-appealed claims 9-11. Appellants may not
reserve arguments for some later time.

discloses a field of consolidated annotation data in Figure 2 (i.e., elements 77, 78, and 79 collectively comprising the single consolidated field). (Ans. 10-11). The Examiner also reads the claimed "linking value" on Bays' disclosure of pointer information that the Examiner finds is generated when it is brought into existence. (Ans. 12-13).

ISSUE

Based upon our review of the administrative record, we have determined that the following issue is dispositive in this appeal:

> Under § 102, does Bays disclose or describe the claimed limitations of "returning an annotation data structure comprising a field containing the linking value and a field containing the consolidated data," and "joining the annotation data structure with the set of data using the generated linking value"? (Claim 1, *see also* the commensurate limitations recited in each of claims 12 and 17).

PRINCIPLES OF LAW

"Whether an invention is anticipated is a question of fact." *Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Educ. and Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003) (citing *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302 (Fed. Cir. 1995)). In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

FINDINGS OF FACT

1.   Bays discloses:

The annotations, together with the pointer information that
relates them to the original database material, may be stored in
a separate source so that the data model and operation of the
sources containing the original database material is not affected.
It is the pointer information that allows formulation of the
queries to retrieve either annotations related to specific database
material or database material related to specific annotations.

(Col. 2, ll. 30-37).

2.   Bays discloses:

For annotation entry, an annotatable data item is chosen (e.g. a 5th
cell in column y of spreadsheet z) and an annotation is entered and
stored. The annotation is associated with the annotatable data item at
the time of entry by including pointer information to the annotatable
data item with the annotation. Optionally, the annotation may be
"propagated" or automatically associated with additional annotatable
data items using extra information defined in the registration step.
Once annotations have been stored, queries may be issued to retrieve
both the annotation content and/or the database material.

(Col. 3, ll. 47-57).

3.   Bays discloses annotation categories 77, 78, and 79 in Figure 2 which
      can be built automatically from concatenation of the annotation
      categories. (Col. 9, ll. 15-16, 19, 24, and 37-38).

ANALYSIS

Independent claims 1, 12, and 17

We decide the question of whether Bays discloses or describes the claimed limitations of "returning an annotation data structure comprising a field containing the linking value and a field containing the consolidated data," and "joining the annotation data structure with the set of data using the generated linking value." (Claim 1, *see also* the commensurate limitations recited in each of claims 12 and 17).

After considering the evidence before us, and the respective arguments on both sides, we find the Bays reference falls short of anticipating Appellants' claimed invention. While we agree with the Examiner (Ans. 12-13) that the claim term "linking value"[2] broadly but reasonably reads on Bays' pointer information that relates the annotations to the database material (FF 1-2), the Examiner's responsive arguments do not persuade us regarding other deficiencies pointed to by Appellants.

In particular, we note that each independent claim before us on appeal requires that the claimed returned annotation structure must comprise at least two fields: a first field <u>containing the linking value</u>, and at least a second field containing consolidated annotated field data. (Claims 1, 12, and 17). Even if agree with the Examiner's finding that the annotation fields (annotation categories 77, 78, and 79) are consolidated in a single field in

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[2] Appellants Specification broadly describes that "[i]n general, the linking value 426 may include *any suitable information* that identifies a corrsponding annotated portion of user data 122." (Spec. 12, para. [0038], emphasis added).

Bays' Figure 2 (FF 3), we nevertheless find that the Examiner has not clearly established in the record where Bays discloses or describes a returned annotation structure that has at least two fields: *one field containing the linking value*, and a second field containing the consolidated annotated field data, within the meaning of independent claims 1, 12, and 17.

While we agree that Bays' pointer information relates or "links" the annotations to the database material (FF 1-2), we note that the language of each independent claim before us on appeal also requires the "linking value" to be a field within the returned annotation data structure. Given that the Examiner has not established where the claimed annotation data structure is disclosed in Bays, we find the additional limitation of "joining the *annotation data structure* [including a linking value field and a consolidated data field] with the set of data *using the generated linking value*" is also not fairly disclosed or described in the Bays reference (Claim 1, *see also* the commensurate limitations recited in each of claims 12 and 17).

We note that "absence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.,* 793 F.2d 1565, 1571 (Fed. Cir. 1986). Accordingly, we reverse the Examiner's anticipation rejection of independent claims 1, 12, and 17, and associated dependent claims 2, 4, 7, 8, 13, 15, 16, and 18-20. Because we have reversed the Examiner's rejection of each independent claim on appeal, we also reverse the Examiner's § 103 rejection of dependent claims 5 and 6.

CONCLUSIONS

1.   Appellants have established that the Examiner erred in rejecting
      claims 1, 2, and 4, 7, 8, 12, 13, and 15-20 under 35 U.S.C. §§ 102(a)
      and 102(e) as anticipated by Bays.

2.   The Board does not have jurisdiction as to non-appealed claims 9-11,
      also rejected by the Examiner as anticipated by Bays. *See Ghuman*, 88
      USPQ2d at 1480.

3.   Appellants have established the Examiner erred in rejecting claims 5
      and 6 under 35 U.S.C. § 103(a) as unpatentable over the combination
      of Bays and Official Notice.

ORDER

      We reverse the Examiner's decision rejecting claims 1, 2, and 4-8, 12,
13, and 15-20.

      Consistent with the holding of BPAI precedential opinion *Ex Parte
Ghuman*, 88 USPQ2d at 1480 (non-appealed claims must be canceled), the
Examiner should cancel non-appealed claims 9-11.

<u>REVERSED</u>

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